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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/654,941 | 09/05/2003 | Ryuichi Sato | 040894-5949 | 5489 |
| 9629 | 7590 | 10/06/2006 | EXAMINER | |
| MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 | | | MORRISON, THOMAS A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3653 | |

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/654,941 | SATO, RYUICHI | |
| | Examiner | Art Unit | |
| | Thomas A. Morrison | 3653 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 9/6/06
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/06/2006 has been entered.

Claim Objections

2. Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In particular, claim 15 depends from claim 12. Also, claim 15 has the same limitations as set forth in the last two lines of claim 12. Thus, claim 15 fails to further limit the subject matter of the previous claim 12.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-5, 7-9 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1 and its dependent claims 3-5, it is unclear in claim 1 if applicant is trying to claim a folding unit so that the folding function can be performed, or not claim such folding unit. One possible solution would be to amend claim 1 to include a folding unit for folding the sheets.

Regarding claim 4, it is unclear if applicant is trying to claim multiple supply portions, or not claim such supplying portions. One possible solution would be to amend claim 4 to include multiple supply portions for supplying sheets to the compiling tray.

Claim 7 recites, "a longitudinal alignment portion". It is unclear if this element is the same or different from the previously recited "an alignment portion" in claim 6.

Claim 8 recites the limitation "the reference position" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "said longitudinal alignment" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 8, it is unclear what is meant by the recited, "controls the reference position in said longitudinal alignment". Is this the longitudinal position of the alignment portion?

Claim 9 recites, "said longitudinal alignment portion". It is unclear if this element refers back to the previously recited "a longitudinal alignment portion" in claim 7, the previously recited "an alignment portion" in claim 6, or both of these previously recited elements. Are these all the same element?

Regarding claim 12 and its dependent claims 13-15, it is unclear in claim 12 if applicant is trying to claim a folding unit so that the folding function can be performed, or not claim such folding unit. One possible solution would be to amend claim 12 to include a folding unit for folding the sheets.

Regarding claim 15, it is unclear if applicant is trying to claim a folding unit so that the folding function can be performed, or not claim such folding unit.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6-9, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication No. 20020113362.

Regarding claim 6, Figs. 18-24 and 28-30(D) show a sheet processing apparatus (Fig. 28) comprising:

a compiling tray (29a) for receiving and stacking conveyed sheets;

a longitudinal reference wall (29b) for performing alignment of sheets stacked on the compiling tray (29d) by aligning rear ends of the sheets (see e.g., Figs. 30(A)-30(D))

Art Unit: 3653

which show that front ends of the sheets enter in the direction of the line with arrows, and then the rear ends of the sheets move into contact with the wall 29b);

an alignment portion (including 18) that gives a conveyance force to sheets sequentially supplied to the compiling tray (29a) to push the supplied sheets against the longitudinal reference wall (29b); and

a controller that controls a position of the alignment portion (including 18) in a direction of thickness of sheets stacked on the compiling tray (29d)(i.e., whatever controls elements 18 to move up and down as shown in Figs. 30A-30D).

Regarding claim 7, Figs. 30a-30d show that a longitudinal alignment portion (including 18) conveys the sheet to the longitudinal reference wall (29b) by using a member (18) that turns by simultaneously touching a surface of the sheet.

Regarding claim 8, as best understood, the controller controls the reference position in the longitudinal alignment according to the number of sheets stacked on the compiling tray (29a). See e.g., numbered paragraphs [0191]-[0192].

Regarding claim 9, Figs. 30a-30d show that the longitudinal alignment portion (including 18) conveys sheets to the longitudinal reference wall (29b) when placed at a sheet alignment position (Fig. 30d), and wherein the longitudinal alignment portion (including 18) once moves from the sheet alignment position (Fig. 30d) to a sheet pressing position (Fig. 30a) in synchronization with predetermined sheet conveying timing, and then returns to the sheet alignment position (Fig. 30d).

5. Claims 6-9, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,145,825 (Kunihiro et al.).

Regarding claim 6, Figs. 1-16c show a sheet processing apparatus (Figs. 2, 7 and 10) comprising:

- a compiling tray (21) for receiving and stacking conveyed sheets;
- a longitudinal reference wall (19) for performing alignment of sheets stacked on the compiling tray (21) by aligning rear ends of the sheets (see Figs. 2 and 10 which show that front ends of the sheets enter in the direction of the line with arrows, and then the rear ends of the sheets move into contact with the wall 19);
- an alignment portion (including 5 and 100) that gives a conveyance force to sheets sequentially supplied to the compiling tray (21) to push the supplied sheets against the longitudinal reference wall (19); and
- a controller that controls a position of the alignment portion (including 5 and 100) in a direction of thickness of sheets stacked on the compiling tray (21)(i.e., whatever controls elements 5 and 100 to move up and down as shown in Figs. 2 and 10 and explained in column 6, lines 10-27).

Regarding claim 7, Figs. 1-16C show that a longitudinal alignment portion (including 5 and 100) conveys the sheet to the longitudinal reference wall (19) by using a member (5) that turns by simultaneously touching a surface of the sheet.

Regarding claim 8, as best understood, Figs. 10, 13 and 15 show that the controller controls the reference position (i.e., the reference position of 100) in the

Art Unit: 3653

longitudinal alignment according to the number of sheets stacked on the compiling tray (21).

Regarding claim 9, Figs. 2 and 10 show that the longitudinal alignment portion (including 5 and 100) conveys sheets to the longitudinal reference wall (19) when placed at a sheet alignment position (upper position), and wherein the longitudinal alignment portion (including 5 and 100) once moves from the sheet alignment position (upper position) to a sheet pressing position (lower position) in synchronization with predetermined sheet conveying timing, and then returns to the sheet alignment position (upper position).

Allowable Subject Matter

6. Claims 1, 3-5 and 12-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 3653

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

09/30/2006


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